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MC LEAN, VA 22102-4231

EXAMINER
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O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/24/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 19

Application Number: 09/303,368  
Filing Date: April 30, 1999  
Appellant(s): Bright et al.

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Andrew M. Calderon  
(Reg. No. 38,093)  
For Appellant

**EXAMINER'S ANSWER**

This examiner's answer has been prepared in response to appellant's brief on appeal  
filed June 26, 2002 (Paper No. 18).

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**(1) *Real Party in Interest***

A statement purportedly identifying the real party in interest is contained in the brief.  
(Assignee of record, *International Business Machines Corporation*.)

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.  
(Claims 2, 5, 7, 10, and 12 have been cancelled.)  
(Claims 1, 3-4, 6, 8-9, 11, and 13-24 are pending, rejected, and the subject of the instant appeal.)

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is *incorrect*.

No amendment has been filed subsequent to the final rejection.

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**(5) Summary of Invention**

The summary of invention contained in the brief is *defective* because it fails to contain a concise explanation of the invention defined in the claims involved in the appeal, which explanation refers to the specification by page and line number, and to the drawings by reference characters, as required by 37 CFR 1.192(c)(5).

(No references to the specification by page and line number.)

**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. A correct statement is as follows:

- I. Whether or not claims 1, 3-4, 6, 8-9, 11, and 13-24 are unpatentable under 35 U.S.C. 103(a) for being obvious over *Blinn et al.* (U.S. Patent No. 6,058,373).
- II. Whether or not claims 1, 3-4, 6, 8-9, 11, and 13-24 are unpatentable under 35 U.S.C. 103(a) for being obvious over *Johnson et al.* (U.S. Patent No. 6,023,683).

**(7) Grouping of Claims**

Claims 1, 3-4, 6, 8-9, 11, and 13-24 stand or fall together for purposes of appeal because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(The brief includes a statement that the rejected claims stand or fall together.)

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**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The prior art of record relied upon in the rejection of claims under appeal is as follows:

✓6,023,683	Johnson et al.	2/2000
✓6,058,373	Blinn et al.	5/2000

**(10) *Grounds of Rejection***

I. Claims 1, 3-4, 6, 8-9, 11, and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Blinn et al.* See, in particular, Figures 13 and 15.

*Blinn et al.* clearly anticipates all of the substantive elements of the instant invention, except that the system of *Blinn et al.* is an integrated, unitary system, performing all necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate processing systems, a “pre-processor” and a “processor.”

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of *Blinn et al.*, so as to split the processing steps/functions out into two separate modules or processing systems, a “pre-processor” and a “processor,” in order

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to improve overall system performance/throughput, since it is well settled that *constructing a formerly integral structure in various elements involves only routine skill in the art*<sup>1</sup>.

II. Claims 1, 3-4, 6, 8-9, 11, and 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Johnson et al.* See, in particular, Figures 1A and 3.

*Johnson et al.* clearly anticipates all of the substantive elements of the instant invention, except that the system of *Johnson et al.* is an integrated, unitary system, performing all necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate processing systems, a “pre-processor” and a “processor.”

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of *Johnson et al.*, so as to split the processing steps/functions out into two separate modules or processing systems, a “pre-processor” and a “processor,” in order to improve overall system performance/throughput, since it is well settled that *constructing a formerly integral structure in various elements involves only routine skill in the art*<sup>1</sup>.

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<sup>1</sup> *Nerwin v. Erlichman*, 168 USPQ 177, 179.

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**(11) Response to Argument**

**I. Claim 1 (Apparatus) is Obvious over Blinn et al.**

Claim 1 recites, and Blinn et al. show, a system (122) for pre-processing (1332) orders (124) before they are transmitted to an order processing (1338) system (348), comprising:

- an order interceptor (346) receiving and pre-processing (1332) electronic sales order data (1100) prior to transmitting to the order processing (1338) system (348);
- an interface system (364) receiving the electronic sales order data (1100) from the order interceptor (346) and performing an availability check, wherein the availability check determines the portions of the electronic sales order data (1100) that can be satisfied; and,
- means for transmitting (322) at least a portion of the electronic sales order data (1100) to the order processing system (348) for order processing (1338).

In particular, Blinn et al. describe the pre-processing system (346) for performing the pre-processing step (1332) from column 36, line 65, to column 37, line 28, and describe the processing system (348) for performing the processing step (1338) immediately thereafter, from column 37, line 29, to column 38, line 37.

Note that, in the system of Blinn et al., the availability check of inventory is indeed performed by element 364, notwithstanding the fact that Blinn et al. refer to their element 364 as the “Product Information Stage” and to their element 386 as the “Inventory Stage.” See, in particular, column 22, lines 14-57, and column 30, lines 4-8.

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Though the system of Blinn et al. discloses all of the elements recited by claim 1--if the claim is read independently of the specification--the claim was rejected as obvious under § 103, rather than anticipated under § 102, because *claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation*<sup>2</sup>, and it was the opinion of the examiner that, if read in light of the specification, some degree of patentable weight should fairly be afforded appellant's recitation of "pre-processing" as something more than simply "processing before additional processing," as the term might otherwise be reasonably interpreted, since, *when not defined by applicant in the specification, the words of a claim must be given their plain meaning, as understood by those of ordinary skill in the art*<sup>3</sup>.

Appellant's disclosed invention clearly dissociates the two processing steps into completely separate, standalone systems, and the specification and written record make clear that appellant views this difference as important in distinguishing the instant invention from the prior art. The specification and written record further establish, that the meanings of the terms "*pre-processor*" and "*processor*"--as defined by appellant--requires dissociation of the two processing systems.

The "pre-processing" and "processing" in the system of Blinn et al. both occur within the same overall system, rather than in two separate and independent systems.

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<sup>2</sup> *In re Marosi*, 218 USPQ 289, 292 (CAFC 1983), emphasis in original.

<sup>3</sup> *In re Sneed*, 218 USPQ 385 (CAFC 1983).



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The instant invention adds no new functionality not disclosed by Blinn et al. The instant invention merely divides the known functionality of a prior art system, such as a system in accordance with the disclosure of Blinn et al., into two separate pieces, a “pre-processor” performing various processing functions and a “processor” performing various subsequent processing functions. None of the functions of the instant invention are any different from the functions disclosed by Blinn et al. Moreover, Blinn et al. indeed disclose a “pre-processing” step performing various processing functions, followed by a subsequent “processing” step performing various processing functions. The only difference from the instant invention being that the “pre-processing” and “processing” performed by the system of Blinn et al. is accomplished by two sub-systems, within one overall system, rather than by two completely separate and independent systems.

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Blinn et al., so as to split the processing steps/functions out into two completely separate and independent modules or processing systems, a “pre-processor” and a “processor,” in order to improve overall system performance/throughput, since it is well settled that *constructing a formerly integral structure in various elements involves only routine skill in the art*<sup>4</sup>.

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<sup>4</sup> *Nerwin v. Erlichman*, 168 USPQ 177, 179.

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Regarding the argument that the claimed invention performs the “pre-processing” steps separately and prior to subsequently performing the “processing” steps, the system disclosed by Blinn et al. indeed performs the “pre-processing” steps (1332) separately and prior to subsequently performing the “processing” steps (1338).

Regarding the argument that the “pre-processing” of the instant invention comprises “novel features” that are not disclosed by Blinn et al., which novel features appellant, notably, fails to specify, but which features, appellant nonetheless argues, “function as a pre-cursor to any actual order placement,” the pre-processing functions (1332) performed by the system of Blinn et al. are indeed performed as a pre-cursor to any actual order placement (1338).

Regarding the argument(s) that the instant invention “amounts to much more” than just splitting the processing of the system of Blinn et al. into separate pieces, any of which “much more” appellant, notably, fails to specify, the instant invention amounts to *no* more than just splitting the processing of the system of Blinn et al. into separate pieces, as the instant invention provides *no* functionality not performed by the system of Blinn et al.

Regarding the argument(s) that the system of Blinn et al. fails to include all “the features and capabilities of the present invention,” the system of Blinn et al. indeed includes *all* of the *claimed* features and capabilities of the present invention, as set forth with specificity

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hereinabove. *Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims<sup>5</sup>.*

Exemplary features which are *argued* by appellant *but not required* by claim 1 include: processing ESOs; processing EPOs; validating criteria before routing the same, altered, or additional ESOs or EPOs to an order processing system; application of “business criteria” to an ESO; providing corrections or alterations, if necessary, based upon the particular customer; asynchronous communication with third party ATP systems; generating multiple ESOs as necessary based upon third party ATP information; generation of reject notices; acting upon an entire order according to pre-defined business rules; organizing ESOs with a predetermined format; known relationship; rules of trading; repetitive automatic processing based on business rules; Just in Time (JIT) relations; forecasts; a router; SAP; OEMLS; other sales order systems; ATP system interface; a system to reject an order; building an error-free order; conversion to multiple orders; analyzing an order for completeness and correctness; etcetera.

Regarding the argument that the system of Blinn et al. is for “on-line consumer shopping” rather than for the same intended use as the instant invention, *a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art<sup>6</sup>.*

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<sup>5</sup> *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

<sup>6</sup> *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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II. Claim 1 (Apparatus) is Obvious over Johnson et al.

Claim 1 recites, and Johnson et al. show, a system (40) for pre-processing (110) orders (46) before they are transmitted to an order processing (120) system, comprising:

an order interceptor (44B) receiving and pre-processing electronic sales order data (46) prior to transmitting to the order processing (120) system;

an interface system (44A) receiving the electronic sales order data (46) from the order interceptor (44B) and performing an availability check (42B), wherein the availability check (42B) determines the portions of the electronic sales order data (46) that can be satisfied; and,

means for transmitting (116) at least a portion of the electronic sales order data (46) to the order processing system for order processing (120).

In particular, Johnson et al. describe the pre-processing step (110) from column 13, line 63, to column 15, line 9, and describe the processing step (120) immediately thereafter, from column 15, line 10, to column 15, line 59.

Though the system of Johnson et al. discloses all of the elements recited by claim 1--if the claim is read independently of the specification--the claim was rejected as obvious under § 103, rather than anticipated under § 102, because *claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their*

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*broadest reasonable interpretation*<sup>7</sup>, and it was the opinion of the examiner that, if read in light of the specification, some degree of patentable weight should fairly be afforded appellant's recitation of "pre-processing" as something more than simply "processing before additional processing," as the term might otherwise be reasonably interpreted, since, *when not defined by applicant in the specification, the words of a claim must be given their plain meaning, as understood by those of ordinary skill in the art*<sup>8</sup>.

Appellant's disclosed invention clearly dissociates the two processing steps into completely separate, standalone systems, and the specification and written record make clear that appellant views this difference as important in distinguishing the instant invention from the prior art. The specification and written record further establish, that the meanings of the terms "pre-processor" and "processor"--as defined by appellant--requires dissociation of the two processing systems.

The "pre-processing" and "processing" in the system of Johnson et al. both occur within the same overall system, rather than in two separate and independent systems.

The instant invention adds no new functionality not disclosed by Johnson et al. The instant invention merely divides the known functionality of a prior art system, such as a system in accordance with the disclosure of Johnson et al., into two separate pieces, a "pre-processor" performing various processing functions and a "processor" performing various subsequent

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<sup>7</sup> *In re Marosi*, 710 F.2d 799, 218 USPQ 289, 292 (Fed. Cir. 1983), emphasis in original.

<sup>8</sup> *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).

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processing functions. None of the functions of the instant invention are any different from the functions disclosed by Johnson et al. Moreover, Johnson et al. indeed disclose a “pre-processing” step (110) performing various processing functions, followed by a subsequent “processing” step (120) performing various processing functions. The only difference from the instant invention being that the “pre-processing” and “processing” performed by the system of Johnson et al. is accomplished by two sub-systems, within one overall system, rather than by two completely separate and independent systems.

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al., so as to split the processing steps/functions out into two completely separate and independent modules or processing systems, a “pre-processor” and a “processor,” in order to improve overall system performance/throughput, since it is well settled that *constructing a formerly integral structure in various elements involves only routine skill in the art*<sup>9</sup>.

Regarding the argument that the system of Johnson et al. allows a user to search catalog databases in order to determine what the user would like to order before ordering it, the argument is irrelevant, as the disclosed searching functionality as a precursor to subsequent “pre-processing” of the order and further subsequent “processing” of the order, is scarcely precluded by any limitation of the claimed invention.

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<sup>9</sup> *Nerwin v. Erlichman*, 168 USPQ 177, 179.

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Regarding the argument that the system of Johnson et al. does not teach intercepting or receiving a “completed” order submission and checking for portions of the sales order that can be satisfied, Johnson et al. indeed explicitly disclose intercepting or receiving (44B) a “completed” order (46) submission and checking (42B) for portions of the sales order (46) that can be satisfied.

Regarding the argument(s) that the system of Johnson et al. fails to include “many of the features of the present invention,” the system of Johnson et al. indeed includes *all* of the *claimed* features and capabilities of the present invention, as set forth with specificity hereinabove.

*Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims<sup>10</sup>.*

Exemplary features which are *argued* by appellant *but not required* by claim 1 include: processing ESOs; processing EPOs; validating criteria before routing the same, altered, or additional ESOs or EPOs to an order processing system; application of “business criteria” to an ESO; providing corrections or alterations, if necessary, based upon the particular customer; asynchronous communication with third party ATP systems; generating multiple ESOs as necessary based upon third party ATP information; generation of reject notices; acting upon an entire order according to pre-defined business rules; automatically checking and processing the order against pre-existing business rules; automatically correcting the order against business rules; a means for automatically detecting errors; providing a means for editing; conditionally

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<sup>10</sup> *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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deciding whether to post an order based on availability; etcetera. In addition, many of these unclaimed features are indeed, nevertheless, disclosed by Johnson et al., as for example, checking the order for errors, as clearly depicted by element 116 in Figure 3.

Regarding the argument that the system of Johnson et al. is for “providing an ability to search multiple catalogs from different suppliers” rather than for the same intended use as the instant invention, *a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art*<sup>11</sup>.

### III. Consideration of Claim 1 (Apparatus) with Respect to the Graham Factual Inquiries

While a determination of *obviousness or non-obviousness under § 103 is ultimately a conclusion of law, that conclusion is predicated on several underlying findings of fact*<sup>12</sup>.

Those questions of fact are:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the art; and,
- (D) Evaluating evidence of secondary considerations.

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<sup>11</sup> *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

<sup>12</sup> *Graham v. John Deere Co.*, 148 USPQ 459 (1966).



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Regarding each of these with respect to the instant case:

(A) The scope and contents of the prior art, as depicted either by Blinn et al. or by Johnson et al., show *each and every* element of the *claimed* invention, except as noted directly below, under “B”.

Appellant’s arguments that certain features are not disclosed in the prior art involve elements that: (1) are indeed disclosed in the prior art exactly as claimed/disclosed by appellant; (2) are disclosed by appellant but unclaimed, and therefore not required in the prior art; or (3) both.

(B) The differences between the prior art, as depicted either by Blinn et al. or by Johnson et al., and the instant claims are simply that the prior art comprises unitary overall systems performing both “pre-processing” and subsequent “processing” rather than separate, individual systems, one performing “pre-processing” and another performing “processing.”

Appellant offers no arguments in contravention to the stated difference between the prior art and the claimed invention.

(C) Regarding the level of ordinary skill in the art, it has been held that, if the only facts of record pertaining to the level of skill in the art are found within the prior art of record, *an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level*<sup>13</sup>.

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<sup>13</sup> *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 218 USPQ 673 (Fed. Cir. 1983).

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Appellant offers no arguments in contravention to the axiom espoused in *Nerwin v. Erlichman*, that separation of a formerly integral structure into various elements involves only routine skill in the art.

(D) Regarding evidence of secondary considerations, there is no evidence of any secondary considerations; one of ordinary skill in the art in could perform the necessary modifications with neither undue experimentation, nor risk of unexpected results; and, any required modification(s) would provide no new or different function, nor any synergistic benefits.

Appellant has offered no arguments whatsoever regarding any secondary considerations, much less any evidence.

In summary, appellant has failed to offer any opposition to, allege any error in, or point out any supposed error in, any of the Graham factual inquiries except for that of the first, “(A) Determining the Scope and Contents of the Prior Art.”

Appellant fails to contravene the examiner’s position regarding differences from the prior art and the stated motivation and rationale for modifying the prior art. Thus, the only question at issue in the instant appeal is a question of fact regarding the scope and contents of the prior art.

It is the finding of the examiner, as trier-of-fact, that, except for being unitary systems, the scope and content of the prior art, as depicted either by Blinn et al. or by Johnson et al., comprises *each and every* element of appellant’s *claimed* invention, as set forth with specificity hereinabove.

Therefore, the rejection under 35 U.S.C. 103(a) is proper and should be sustained.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT  
APPEALS AND INTERFERENCES

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GROUP 3600

In re patent application of

M. Bright, et al.

Serial No.: 09/303,368

Group Art Unit: 2167

Filed: April 30, 1999

Examiner: O'Connor, Gerald J.

For: PRE-PROCESS FOR INBOUND SALES ORDER REQUESTS WITH  
LINK TO A THIRD PARTY AVAILABLE TO PROMISE SYSTEM

Assistant Commissioner for Patents  
Washington, D.C. 20231

REQUEST FOR ORAL HEARING UNDER 37 C.F.R. 1.194

Sir:

Applicants hereby request an oral hearing before the Board of Patent Appeals and Interferences. Please charge International Business Machines Corporations Deposit Account 09/0456 (IBM Essex Junction) in the amount of \$280.00 to cover the request fee as set forth in 37 C.F.R. § 1.17(d). Please charge and deficiencies and credit any overpayment to the same.

Respectfully submitted,

Andrew M. Calderon  
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